

THIS OPINION IS
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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

wellington

Mailed: February 3, 2004

Cancellation No. 92032495

FLAGEOLI, LTD.

v.

GAIL A. MAYRON

Before Simms, Bucher and Rogers, Administrative Trademark
Judges.

By the Board:

On September 24, 2001, Flageoli, Ltd.
("petitioner") filed a petition to cancel the
registration of Gail A. Mayron ("respondent") for the
mark SERIOUS MOISTURE, registered for goods identified
as "cosmetic and personal care products, namely, hand
creams, body creams, oral hygienes in the nature of
mouthwash, skin fresheners in the nature of toners, body
sports cremes, solid perfume sticks, non-medicated lip

balm, face balms and body soaps," in International Class 3.¹

In pertinent part, petitioner alleges that it is the owner of Registration No. 2,275,096 for the mark SERIOUS SKIN CARE for non-medicated skin care lotions in International Class 3 and that the mark has been used in commerce since October 5, 1995; that petitioner is the owner of application Serial No. 75522195 for the mark SERIOUS E for facial creams, lotions and moisturizers in International Class 3 and has used the mark in commerce since April 16, 1998;² that it has used its marks in commerce prior to respondent's first use of her mark; that "[respondent's mark] is so confusingly similar to petitioner's trademarks that confusion, mistake, and deception, *inter alia*, in the relevant public is likely to result"; that petitioner's mark SERIOUS SKIN CARE is famous "having been advertised and marketed to millions of consumers and sold over nationwide television for several years"; that respondent's mark SERIOUS MOISTURE

¹ Registration No. 2,468,269, issued July 10, 2001, claiming October 4, 1999 as both the date of first use anywhere and date of first use in commerce.

² On January 15, 2002, application Serial No. 75522195 matured into Registration No. 2,530,172 for the mark "SERIOUS E" for skin care products, namely, facial creams, lotions and moisturizers in International Class 3.

"has the effect of diluting petitioner's mark SERIOUS SKIN CARE in violation of [15 U.S.C. § 1125(c)(1)]"; and, as a result thereof, that petitioner will be damaged if respondent's registration is not cancelled.

A status and title copy of petitioner's pleaded registration for SERIOUS SKIN CARE was not filed with the petition to cancel.

In its answer, respondent admits that "[p]etitioner is the current owner according to the Patent and Trademark Office assignment records of Registration No. 2,275,096"; that "[p]etitioner is the current owner according to the Patent and Trademark Office assignment records of Trademark Application Serial No. 75/522,195 (now Registration No. 2,530,172) for the mark "SERIOUS E" on skin care products, namely, facial creams, lotions and moisturizers in International Class 3"; and that respondent is the owner of Registration No. 2468269 for the mark SERIOUS MOISTURE on hand creams, body creams and face balms and skin fresheners. Respondent otherwise denies all other salient allegations in the petition or states she is without knowledge or information sufficient to form a belief as to the truth

of the averments in certain allegations. Respondent also asserted certain pro forma affirmative defenses.

At trial, neither petitioner nor respondent introduced evidence.³ Also, neither petitioner nor respondent filed a trial brief.

On August 19, 2003, the Board issued an order allowing petitioner time to show cause why the Board should not treat its failure to file a brief as a concession of the case under Trademark Rule 2.128(a)(3).

On September 17, 2003, petitioner responded to the Board's show cause order wherein it argued that it was "unable to address the briefing schedule in the within matter" due to an illness in the family of petitioner's counsel of record.⁴ Petitioner requested the Board to reopen the briefing deadlines.

³ As reset by the Board on September 2, 2002, discovery closed on December 13, 2002 and petitioner's testimony period closed on February 13, 2003.

⁴ In a reply brief, petitioner elaborated on the circumstances and stated that "petitioner's attorney, a sole practitioner, was the primary caretaker of her mother, who fell ill in October, 2002 and was hospitalized in December, 2002. From October, 2002 through March, 2003, Petitioner's attorney was traveling every 2-4 weeks between Los Angeles and New Jersey caring for her mother. During that time, Petitioner was unable to offer any evidence in its behalf during the testimony period, which closed on February 13, 2003."

Respondent has opposed petitioner's request to reopen the briefing periods.

Turning to the Board's show cause order, we accept petitioner's response as evidence that it has not lost interest in this matter. Accordingly, the order to show cause is hereby discharged.

We now turn to petitioner's motion to reopen the time for it to file its trial brief. Under Fed. R. Civ. P. 6(b), a moving party must show that its failure to act during the time previously allotted therefor was the result of excusable neglect. See TBMP § 509.01(b) (2d ed. June 2003). Although we found that petitioner has not lost interest in this case, we do not find that petitioner has made the necessary showing that its failure to file a trial brief in this case was the result of excusable neglect. See *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000). Petitioner has not sufficiently explained why it did not file a motion or otherwise request additional time to file a trial brief. In its reply brief, petitioner's counsel states that she was preoccupied from October 2002 until March 2003. However, petitioner's counsel offers no explanation as

to why she delayed taking action after March 2003 and only filed petitioner's request to reopen the briefing periods nearly six months thereafter in response to the Board's show cause order. Accordingly, petitioner's motion to reopen the time for it to file its trial brief is hereby denied.

Even if the Board did find excusable neglect and agreed to reopen the briefing periods, allowing the parties to file briefs would be of little value in view of the scant record before us. Petitioner failed to take any testimony or offer any evidence in its behalf during its testimony period. Furthermore, as noted previously, petitioner did not submit current status and title copies of its registrations, i.e., the registration originally pleaded or the registration that issued after commencement of the proceeding, and thus did make them of record under Trademark Rule 2.122(d). 37 CFR § 2.122(d)(1); see also *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); and *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990); and *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984).

Notwithstanding petitioner's failure to submit status and title copies of the pleaded marks, we find that respondent's answer to the complaint contains admissions sufficient for considering one of the pleaded marks to be of record. See TBMP § 704.03(b)(1)(A) (2d ed. June 2003) and cases cited therein. Specifically, in paragraph 2 of its answer, respondent not only admitted that petitioner was the owner of application Serial No. 75522195 but also acknowledged the application very recently matured into Registration No. 2530172. Indeed, the registration issued less than two months before respondent's answer was filed. The Board therefore deems respondent's admission as sufficient for purposes of establishing the registration's current status and title.⁵

Thus the record before us consists solely of the pleadings, the file of the involved registration which is automatically of record under Trademark Rule 2.122(b), and, as explained above, petitioner's pleaded mark SERIOUS E (subject of Registration No. 2530172).

⁵ Although respondent also admitted that petitioner was the owner of Registration No. 2,275,096, the Board finds this admission alone to be insufficient for purposes of considering this registration in the record. See TBMP § 704.03(b)(1)(A) (2d ed. June 2003) and cases cited therein.

We can now turn to the petitioner's likelihood of confusion claim.⁶ In determining the issue of likelihood of confusion, we must analyze all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Because the evidence of record before us is limited to the parties' respective registrations, we have no evidence which bears on certain of the factors. Nonetheless, the two key considerations in any likelihood of confusion analysis are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). With respect to the parties' goods, they are, in part, identical. Petitioner's registration covers "skin care products, namely, facial creams, lotions and moisturizers" and respondent's registration

⁶ Priority is not in issue. The Board has held that, in the absence of testimony or other evidence relating to priority of the parties' marks in their respective registrations, priority lies with the registrant which owns the registration based upon the application with the earlier filing date. See, e.g., *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1428-29 (TTAB 1993) at n. 13; and *American Standard Inc. v. AQM Corp.*, 208 USPQ 840, 841-42 (TTAB 1980). This is the case at hand, i.e., the application upon which petitioner's registration is based was filed on June 19, 1998 and respondent's registration is based on an application filed on February 18, 1999. Because there is no other evidence or

covers "hand creams, body creams, face balms and skin fresheners" among other items. Because of the absence of any restrictions in the respective identifications, these identical goods must also be deemed to be offered in the same channels of trade to the same groups of consumers.

In comparing the parties' marks, we find that while both petitioner's mark SERIOUS E and respondent's mark SERIOUS MOISTURE contain the identical term "serious," the marks also contain additional matter. Thus, considered in their entireties, the marks have a different sound, appearance and meaning. While respondent's registration contains a disclaimer of the term "moisture," we must consider the mark in its entirety when determining whether there is likelihood of confusion and a disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *In re MCI Communications Corp.*, 21 USPQ2d 1535 (Comm'r Pats. 1991). When each

testimony of record relating to priority, petitioner prevails on

mark is viewed as a whole, they will likely be perceived by consumers as having the respective connotations of extreme or intense "E" and extreme or intense moisture.⁷ These are very different connotations.

In view of the above, and notwithstanding that the identified goods are in part identical, and notwithstanding the parties' presumptive use of the same channels of trade and marketing to the same classes of consumers, we do not find a likelihood of mistake, confusion or deception of consumers.

We finally turn to petitioner's second ground for cancellation, that under Section 43(c) of the Lanham Act, the use of registrant's mark SERIOUS MOISTURE would cause dilution of the petitioner's famous mark, SERIOUS SKIN CARE. As noted above, opposer made of record no evidence on which the conclusion that its mark is famous could be based. In a similar sense, there is no evidence of record demonstrating that the use of registrant's mark would cause the dilution of petitioner's mark. In view thereof, this claim is

the issue of priority.

⁷ While it is plausible that petitioner's use of "E" in its mark could be a reference to an Vitamin E or Echinacea supplement, or maybe to using plaintiff's products to treat Eczema, or to something else entirely, we cannot conclude with any certainty what the E refers to

hereby denied. Trademark Act section 43(c)(1); See also *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001).

Because petitioner is the plaintiff herein, it is the party who bears the burden of proof in this proceeding. In this respect, petitioner has failed to prove its allegations in the petition to cancel (which have been denied by respondent) by a preponderance of the evidence. Decision: The petition to cancel is denied.

because petitioner has not put anything into the record which provides an explanation.